| CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)<br>Applicant(s):   Haynes et al. | Docket No.<br>RSW920010084US1 |
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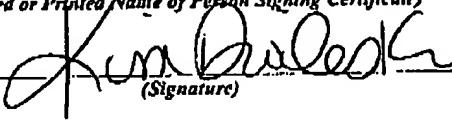| Application No.<br>09/845,362 | Filing Date<br>4/30/2001 | Examiner<br>Garg, Yogesh C. | Group Art Unit<br>3625 |
|---|---|---|---|

Invention:   METHOD FOR MANAGING AN ELECTRONIC-COMMERCE SHOPPING CART

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| TRANSMITTAL OF APPEAL BRIEF (Large Entity) | Docket No. RSW920010084US1 |
|---|---|

In Re Application Of:   Haynes et al.

| Application No. 09/845,362 | Filing Date 4/30/2001 | Examiner Garg, Yogesh C. | Customer No. 30449 | Group Art Unit 3625 | Confirmation No. |
|---|---|---|---|---|---|

Invention:   METHOD FOR MANAGING AN ELECTRONIC-COMMERCE SHOPPING CART

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on 4/11/2005

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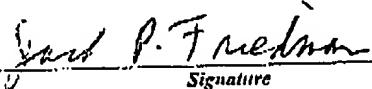
_Jack P. Friedman_
_Signature_

Dated:   6/13/2005

Jack P. Friedman
Reg. No. 44,688
Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, NY 12110
(518) 220-1850

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Dkt No. RSW920010084US1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Haynes *et al.*                    Group Art Unit: 3625

Filed: 4/30/2001                              Examiner: Garg, Yogesh C.

Serial No.: 09/845,362

Title: METHOD FOR MANAGING AN ELECTRONIC -COMMERCE SHOPPING
CART

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## BRIEF OF APPELLANT

This Appeal Brief, pursuant to the Notice of Appeal filed April 11, 2005, is an appeal

from the rejection of the Examiner in the Office Action dated January 11, 2005.

## REAL PARTY IN INTEREST

International Business Machines, Inc. is the real party in interest.

## RELATED APPEALS AND INTERFERENCES

None.

## STATUS OF CLAIMS

Claims 1-4 and 13–28 are rejected. Claims 5-12 are canceled. This Appeal Brief is in

support of an appeal from the rejection of claims 1-4 and 13–28.

09/845,362

## STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

## SUMMARY OF CLAIMED SUBJECT MATTER

The present invention discloses a method and system for managing an electronic commerce (e-commerce) shopping cart relating to communication between a shopper and a server (e.g., a merchant's server) over a communication network (e.g., the Internet). See FIG. 1; specification, page 6, lines 1-5.

The server determines whether a shopping command of the shopper has changed an attribute of a primary item in the shopping cart. See specification, page 7, lines 13-15. After the server has determined that the shopping command has changed the attribute of the primary item in the shopping cart, the server identifies a secondary item in the shopping cart linked to the primary item. See specification, page 8, lines 9-12. The server changes a corresponding attribute of the secondary item in response to the change in the attribute of the primary item. See specification, page 8, lines 18-20.

After the server identifies a secondary item in the shopping cart linked to the primary item and before the server changes a corresponding attribute of the secondary item in response to the change in the attribute of the primary item, the server solicits and receives by authorization from the shopper to change the corresponding attribute of the secondary item in response to the change in the attribute of the primary item. See specification, page 8, lines 14-18. The

09/845,362

2

authorization may be explicit or implicit. See specification, page 9, lines 1-3.

Before the server determines whether a shopping command of the shopper has changed an attribute of a primary item in the shopping cart, the server waits for the shopping command and continues to wait so long as the shopping command has not been received by the server. See specification, page 7, lines 11-13.

After the server determines that the shopping command has changed an attribute of a primary item in the shopping cart and before the server identifies a secondary item in the shopping cart linked to the primary item, it is ascertained whether the primary item is a new primary item, and after said ascertaining has ascertained that the primary item is not the new primary item, then the step of identifying a secondary item in the shopping cart linked to the primary item is performed. See specification, page 8, lines 9-13.

The attribute of the primary item and the corresponding attribute of the secondary item may be a same attribute. See specification, page 3, lines 8-12.

The attribute of the primary item and the corresponding attribute of the secondary item may be different attributes. See specification, page 9, lines 14-19.

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-4, 14-22 and 24-28 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable over Henson et al.

2. Claims 13 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

09/845,362

3

## ARGUMENT

## GROUND OF REJECTION 1

Claims 1-4, 14-22 and 24-28 stand rejected under 35 U.S.C. §102(e) as allegedly being

unpatentable over Henson et al.

### Claims 1, 17-19, and 27-28

Appellants respectfully contend that claims 1 and 19 are not anticipated by Henson,

because Henson does not teach each and every feature of claim 1. For example, Henson does not

teach or suggest the feature: "after the server has determined that the shopping command has

changed the attribute of the primary item in the shopping cart, identifying by the server a

secondary item in the shopping cart linked to the primary item; and changing by the server a

corresponding attribute of the secondary item in response to the change in the attribute of the

primary item" (emphasis added).

The Examiner argues that Henson, col. 15, lines 31-45 teaches the preceding feature of

claims 1 and 19.

Appellants respectfully contend that Henson, col. 15, lines 31-45 does not teach the

preceding feature of claims 1 and 19. In particular, Henson, col. 15, lines 31-44 recites:

"Everything in the configurator is specific to a given computer system (i.e., chassis) per customer

or per set of customers. The welcome page is geared towards identifying a chassis. Given the

chassis, the configurator displays the universe or possible options within that chassis, for a given

customer set. Messaging has now been included in that option universe to assist a user in

09/845,362

4

choosing a best selection for that user. If a user decides upon a different chassis, the user must return to the welcome page and select another chassis. The options within the configurator are dependent upon the chassis. If a user wants to go to a different universe, then the user must exit the configurator, go back to the welcome page, and select a new universe (i.e., a different chassis)."

In the preceding quote from Henson, the Examiner alleges that a chassis is a primary item in the shopping cart of the user, and by deciding upon a different chassis the user has changed an attribute of the chassis. A first point is that Henson's language of "decid[ing] upon a different chassis" is ambiguous and could mean that the user has selected a different chasis in addition to an initially selected chassis. Therefore, the user's assumption that Henson's language of "decid[ing] upon a different chassis" means changing an initially selected chassis to a different chassis is speculative and is hereby challenged by Appellants. The Examiner has a burden to prove that Henson's language of "decid[ing] upon a different chassis" does not mean that the user has selected a different chasis in addition to an initially selected chassis.

However, even if Henson's language is interpreted to mean changing an initially selected chassis to a different chassis, Hanson col. 15, lines 31-44 does not disclose "identifying by the server a secondary item in the shopping cart linked to the primary item". In other words, Hanson col. 15, lines 31-44 does not disclose the existence of any secondary item in the user's shopping cart that is linked to the originally selected chassis. The Examiner argues that the options presented to the user after the user has selected a different chassis are secondary items. However, these menu items presented to the user are not in the user's shopping cart, as required by claims 1

09/845,362

5

and 19.

In other words, claims 1 and 19 require that the server change an attribute of a secondary item in the shopping cart in response to a change in the primary item that is also in the shopping cart. The Examiner's argument has totally disregarded the requirement in claims 1 and 19 that both the primary item and its linked secondary item must be in the shopping cart before the user changes an attribute of the primary item, and therefore before the server changes a corresponding attribute of the secondary item. Henson simply does not teach "identifying by the server a secondary item in the shopping cart linked to the primary item".

In addition, what happens in claims 1 and 19 is that a secondary item is first in the shopping cart and then its attribute is changed (in response to the change in the attribute of the primary item). The secondary item remains in the shopping cart after its attribute is changed. The secondary item doesn't mysteriously jump out of the shopping cart when its attribute is changed. Appellants' specification, page 9, lines 13-14 presents the example of: "if the size of the primary item ix X, then the size of the secondary item is appropriate to match X".

The idea behind claims 1 and 19 is that once the user changes an attribute of the primary item in the shopping cart, the user is relieved of the burden of changing a corresponding attribute of the secondary item in the shopping cart. The work of changing the corresponding item of the secondary item in the shopping cart is instead done by the server. The language of claims 1 and 19 captures this idea.

In contrast, Henson's server never changes an attribute of a secondary item in the user's shopping cart. All that Henson's server does is to present a menu of options to the user and

09/845,362

6

forces the user to change the attribute of a secondary item by making a selection from the menu. Henson's server simply does not do the job required of it in claims 1 and 19, namely to actually change the attribute of the secondary item in the shopping cart. Again, Henson's server doesn't want to be bothered to make this change and instead forces the user to make this change by presenting a menu of options to the user and telling the user to make a selection. The user's selection from the menu is what changes the attribute of the secondary item in the shopping cart.

Based on the preceding arguments, Appellants respectfully maintain that Henson does not anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance. Since claims 17-18 depend from claim 1, Appellants contend that claims 17-18 are likewise in condition for allowance. Since claims 27-28 depend from claim 19, Appellants contend that claims 27-28 are likewise in condition for allowance.

Claims 2 and 20

Since claims 2 and 20 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 2 and 20 are likewise not anticipated by Henson.

In addition with respect to claims 2 and 20, Henson does not teach the feature: "soliciting and receiving by the server authorization from the shopper to change the corresponding attribute of the secondary item in response to the change in the attribute of the primary item".

The Examiner argues that Henson, col. 8, lines 7-55 teaches the preceding feature of

09/845,362

7

claims 2 and 20.

In response, Appellants respectfully contend that in Henson, col. 8, lines 7-55, the server does no more than issue a warning to the shopper of an incompatibility in the shopper's selection of options. However, a warning of said incompatibility is not a solicitation for authorization to change an attribute of the secondary item, as confirmed by the Examiner's citation of Henson, col. 8, lines 53-55 ("The customer can then modify, change, and/or delete the particular option which gave rise to the validation warning."). In other words, Henson teaches what the customer can do, but does not teach soliciting said authorization as required by claims 2 and 20.

Moreover, what the Examiner alleges to represent server authorization in Henson, col. 8, lines 7-55 is not disclosed by Henson as authorization for: "chang[ing] the corresponding attribute of the secondary item in response to the change in the attribute of the primary item" as required by claims 2 and 20.

Accordingly, claims 2 and 20 are not anticipated by Hanson.


Claims 3-4 and 21-22

Since claims 3-4 and 21-22 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 3-4 and 21-22 are likewise not anticipated by Henson.

In addition with respect to claims 3-4 and 21-22, Henson does not teach the features: "wherein said authorization is explicit" (claims 3 and 21) and "wherein said authorization is implicit" (claims 4 and 22)

09/845,362

8

The Examiner argues that Henson, col. 8, line 62 - col. 9, line 8 teaches the preceding features of claims 3-4 and 21-22.

In response, Appellants respectfully contend that in Henson, col. 8, line 62 - col. 9, line 8 only teaches validation and does not teach authorization generally, and particularly does not teach authorization for: "chang[ing] the corresponding attribute of the secondary item in response to the change in the attribute of the primary item" as required by claims 3-4 and 21-22.

Accordingly, claims 3-4 and 21-22 are not anticipated by Henson.

## Claims 14 and 24

Since claims 14 and 24 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 14 and 24 are likewise not anticipated by Henson.

In addition with respect to claims 14 and 24, Henson does not teach the feature: "ascertaining whether the primary item is a new primary item; and after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step".

The Examiner argues that Henson, col. 15, lines 31-45 teaches the preceding feature of claims 14 and 24.

In response, Appellants respectfully contend that in Henson, col. 15, lines 31-45 does not teach performing the identifying step if the primary item is not the new primary item, wherein the identifying step is "identifying by the server a secondary item in the shopping cart linked to the

09/845,362

9

primary item". There is a conspicuous lack of any such "identifying" in Henson, col. 15, lines 31-45. Moreover,

Accordingly, claims 14 and 24 are not anticipated by Hanson.

## Claims 15 and 25

Since claims 15 and 25 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 15 and 25 are likewise not anticipated by Henson.

In addition with respect to claims 15 and 25, Henson does not teach the feature: "wherein the attribute of the primary item and the corresponding attribute of the secondary item are a same attribute".

The Examiner argues: "Regarding claim 15, Henson discloses that in the method of claim 1, wherein the attribute of the primary item and the corresponding attribute of the secondary item are a same attribute (see at least col.6, lines 44-67), which discloses the attribute of lead time/delivery and this attribute is same for both the computer system [the primary item] and the options [secondary items]0."

In response, Appellants note by reference to claims 1 and 19 on which claims 15 and 25 respectively depend, that Henson, col.6, lines 44-67, teaches attributes of long lead time, but does not teach that primary and secondary item in the shopping cart both have the same attribute of long lead time.

Accordingly, claims 15 and 25 are not anticipated by Hanson.

09/845,362

10

Claims 16 and 26

Since claims 15 and 25 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be anticipated by Henson, Appellants maintain that claims 16 and 26 are likewise not anticipated by Henson.

In addition with respect to claims 16 and 26, Henson does not teach the feature: "wherein the attribute of the primary item and the corresponding attribute of the secondary item are different attributes".

The Examiner argues: "Regarding claim 16, Henson teaches that in the method of claim 1, wherein the attribute of the primary item and the corresponding attribute of the secondary item are different attributes (see at least Figs 3A and 3B wherein the attributes of the computer system, that is Dell Dimension XPS R, reference numbers "79"[primary item] in FIG.3A and Printer [secondary item] in Fig.3B have different attributes."

In response, Appellants note by reference to claims 1 and 19 on which claims 16 and 26 respectively depend, that Henson, does not teach that Dell Dimension system in FIG. 3A and the Printer in FIG. 3B are in the user's shopping cart. In fact, Henson, col. 6, lines 18-21 discloses only that FIGS. 3A and 3B show screens from which a customer can build a customer configured machine

Accordingly, claims 16 and 26 are not anticipated by Hanson.

09/845,362

11

## GROUND OF REJECTION 2

Claims 13 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

The Examiner rejected claims 13 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

Since claims 13 and 23 respectively depend from claims 1 and 19, which Appellants have argued *supra* to not be unpatentable over Henson under 35 U.S.C. §102(e), Appellants maintain that claims 13 and 23 are likewise not unpatentable over Henson in view of Chandramohan under 35 U.S.C. §103(a).

In addition, with respect to claims 13 and 20, Henson in view of Chandramohan does not teach the feature: "wherein before said determining step, said method further comprising the step of: waiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server".

The Examiner argues: "Chandramohan discloses the step of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server (see at least col.7, line 27-col.8, line 12," *FIG. 3A is a timing diagram that illustrates the method and operation of the present embodiment. As a background activity, the a-serve server module 101 monitors the network 146 (as shown in FIG. 1A) and waits for requests from a-serve client modules 103, as shown in element 306* "). In view of Chandramohan, it would have been obvious to one of an ordinary

09/845,362

12

skill in the art at the time of the applicant's invention to have incorporated the feature of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server because it is well-known that the Transmission Control Protocol/Internet Protocol (TCP/IP) is a 'common networking protocol used for communication among computer-systems 100 that allows uniform formatting of data for transmittal and receipt and enabling the e-server to communicate with the client modules.".

In response, Appellants respectfully contend that the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive

A first reason why the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that the Examiner's citation of Chandramohan describes the e-server module waiting for requests from e-serve client modules, which is not equivalent to waiting for a shopping request as is required in claims 13 and 20.

A second reason why the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that modifying Henson because "(TCP/IP) is a common networking protocol used for communication among computer-systems " seems illogical as a reason for modifying Henson. In fact, Chandramohan discussion of TCP/IP in col. 7, lines 39-46 does not relate the use of TCP/IP as motivation for the e-server module waiting for requests from e-serve client modules in col. 7, lines 28-31.

Accordingly, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 13 and 23.

09/845,362

13

## SUMMARY

In summary, Appellant respectfully requests reversal of the January 11, 2005 Office Action rejection of claims 1-4 and 13–28.

Respectfully submitted,

*Jack P. Friedman*

Jack P. Friedman
Attorney For Appellant
Registration No. 44,688

Dated:  06/13/2005

Schmeiser, Olsen & Watts
3 Lear Jet Lane - Suite 201
Latham, New York 12110
(518) 220-1850

09/845,362

14

Dkt No. RSW920010084US1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Haynes *et al.*                  Group Art Unit: 3625

Filed: 4/30/2001                            Examiner: Garg, Yogesh C.

Serial No.: 09/845,362

Title: **METHOD FOR MANAGING AN ELECTRONIC-COMMERCE SHOPPING CART**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## APPENDIX A - CLAIMS ON APPEAL

1. A method for managing an electronic commerce (e-commerce) shopping cart relating to communication between a shopper and a server over a communication network, said method comprising the steps of:

   determining by the server whether a shopping command of the shopper has changed an attribute of a primary item in the shopping cart;

   after the server has determined that the shopping command has changed the attribute of the primary item in the shopping cart, identifying by the server a secondary item in the shopping cart linked to the primary item; and

   changing by the server a corresponding attribute of the secondary item in response to the change in the attribute of the primary item.

2. The method of claim 1, wherein after said identifying step and before said changing step, said

09/845,362                                15

method further comprising the steps of:

     soliciting and receiving by the server authorization from the shopper to change the corresponding attribute of the secondary item in response to the change in the attribute of the primary item.

3. The method of claim 2, wherein said authorization is explicit.

4. The method of claim 2, wherein said authorization is implicit.

13. The method of claim 1, wherein before said determining step, said method further comprising the step of: waiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server.

14. The method of claim 1, wherein after said determining step has determined that the shopping command has changed the attribute of said primary item and before said identifying step, said method further comprising the steps of:

     ascertaining whether the primary item is a new primary item; and

     after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step.

15. The method of claim 1, wherein the attribute of the primary item and the corresponding

09/845,362                                              16

attribute of the secondary item are a same attribute.


16. The method of claim 1, wherein the attribute of the primary item and the corresponding attribute of the secondary item are different attributes.


17. The method of claim 1, wherein the communication network comprises the Internet.


18. The method of claim 1, said determining, identifying, and changing steps being performed for a merchant of the primary item.


19. A system, comprising a server adapted to implement a method for managing an electronic commerce (e-commerce) shopping cart relating to communication between a shopper and a server over a communication network, said method comprising the steps of:

determining by the server whether a shopping command of the shopper has changed an attribute of a primary item in the shopping cart;

after the server has determined that the shopping command has changed the attribute of the primary item in the shopping cart, identifying by the server a secondary item in the shopping cart linked to the primary item; and

changing by the server a corresponding attribute of the secondary item in response to the change in the attribute of the primary item.


20. The system of claim 19, wherein after said identifying step and before said changing step,

09/845,362                    17

said method further comprising the step of:

    soliciting and receiving by the server authorization from the shopper to change the corresponding attribute of the secondary item in response to the change in the attribute of the primary item.

21. The system of claim 20, wherein said authorization is explicit.

22. The system of claim 20, wherein said authorization is implicit.

23. The system of claim 19, wherein before said determining step, said method further comprising the step of: waiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server.

24. The system of claim 19, wherein after said determining step has determined that the shopping command has changed the attribute of said primary item and before said identifying step, said method further comprising the steps of:

    ascertaining whether the primary item is a new primary item; and

    after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step.

25. The system of claim 19, wherein the attribute of the primary item and the corresponding

09/845,362                              18

attribute of the secondary item are a same attribute.


26. The system of claim 19, wherein the attribute of the primary item and the corresponding attribute of the secondary item are different attributes.


27. The system of claim 19, wherein the communication network comprises the Internet.


28. The system of claim 19, said determining, identifying, and changing steps being performed for a merchant of the primary item.


09/845,362                                   19

**Dkt No. RSW920010084US1**

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Serial No.: 09/845,362

Title: **METHOD FOR MANAGING AN ELECTRONIC-COMMERCE SHOPPING CART**

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## APPENDIX B - EVIDENCE

There is no evidence entered by the Examiner and relied upon by Appellants in this

appeal.

09/845,362                              20

Dkt No. RSW920010084US1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Haynes *et al.*                            Group Art Unit: 3625

Filed: 4/30/2001                                      Examiner: Garg, Yogesh C.

Serial No.: 09/845,362

Title: **METHOD FOR MANAGING AN ELECTRONIC -COMMERCE SHOPPING**

**CART**

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## APPENDIX C - RELATED PROCEEDINGS

There are no proceedings identified in the "Related Appeals and Interferences" section.

09/845,362                                21